

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Daisuke ITOH, et al.
App. No	: 10/571,507
Filed	: March 10, 2006
For	: METAL NANOPARTICLE DISPERSION USABLE FOR EJECTION IN THE FORM OF FINE DROPLETS TO BE APPLIED IN THE LAYERED SHAPE
Examiner	: Maki A. Angadi
Art Unit	: 1792
Conf No.	: 4217

RESPONSE TO RESTRICTION REQUIREMENT**Mail Stop Amendment**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In the Restriction Requirement ailed March 24, 2009, The Examiner required restriction of prosecution to one of the following inventions under PCT Rule 13.1.

Group I: Claims 1-5, 9 and 10 drawn to metal nanoparticle dispersion

Group II: Claims 6-8, 11 and 12 drawn to a process of forming an electro-conductive layer.

In response to the Restriction Requirement, Applicants provisionally elect Group I: Claims 1-5, 9 and 10, with traverse. Applicants reserve the right to seek rejoinder of the process claims, in the event the traversal is not successful. Moreover, the Applicants reserve the right to file divisional applications directed to any of the non-elected claims.

As recognized by the Examiner, the standard to be applied regarding restriction in national phase application is the standard under PCT Rule 13.1. The Examiner contended that

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Claims lack of a common inventive feature because Group II requires the inventive feature of a “sintered” product layer of nanoparticles which is not included in Group I. Applicants respectfully submit that the pending Claims 1-12 share the same corresponding special technical features under PCT Rule 13.2, accordingly Group I and II by no means lack unity of invention under PCT Rule 13.1, as discussed below.

A copy of the authorized English translation of the International Preliminary Report on Patentability (Chapter 1) for PCT/JP2004/013229, submitted herewith, reported clearly that the originally filed Claims 1-12 have novelty and inventive step over the Document 1 (WO 02/018080A) and the Document 2 (JP 10-204350) cited in the International Search Report and no lack of “unity of invention” was alleged by the authorized officer of the international stage.

Indeed, Claims 6-8, 11, and 12 recite “A process for forming, on a substrate, an electroconductive layer with good conductivity having a fine shape, which is consisting of a sintered product layer of metal nanoparticles, using the metal nanoparticle dispersion as claimed in Claim 1.” The recitation is considered to be substantially equivalent to “A method of using the metal nanoparticle dispersion as claimed in Claim 1 for forming, on a substrate, an electroconductive layer with good conductivity having a fine shape, which is consisting of a sintered product layer of the metal nanoparticles,”

As discussed, Claim 1 recites “metal nanoparticle dispersion” and Claim 6, as well as the rest of the claims in Group II, substantially recites “a method of using the metal nanoparticle dispersion as claimed in Claim 1.” Thus, Claims 6-8, 11 and 12 appear to have the same or corresponding technical features under PCT Rule 13.1. The addition of the “sintered” product layer to Group II does not alter this conclusion.

Therefore, Applicants believe that the opinion of the International Preliminary Report as to the “Unity of Invention” under PCT Rule 13.1 should be applied to the current pending Claims 1-12 of the present U.S. application, which is just submitted in National Phase of PCT/JP2004/013229 in U.S.A.

In view of the comments presented above, Applicants respectfully request reconsideration and withdrawal of the Restriction Requirement, and examination of all pending claims.

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No fees are believed to be due. However, please charge any fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 16, 2009

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